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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,711	03/10/2004	Robert W. Driscoll	54317-029101	6173
46560 7590 07/08/2008 THE WALT DISNEY COMPANY C/O GREENBERG TRAURIG LLP 2450 COLORADO AVENUE SUITE 400E SANTA MONICA, CA 90404				
EXAMINER				
DUFFY, DAVID W				
ART UNIT		PAPER NUMBER		
3714				
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07/08/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/798,711

**Applicant(s)**

DRISCOLL ET AL.

**Examiner**

DAVID W. DUFFY

**Art Unit**

3714

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 19-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. This office action is in response to the amendment filed 05/12/2008 in which applicant amends claims 1, 5-6, 9, and 19. Claims 1-11 and 19-27 are pending.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/12/2008 has been entered.

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-11 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabai et al. (US 6352478) in view of Rose; William J. (US 4857030 A).
5. In regards to claim 1, Gabai discloses a system that has a number of fanciful toy figures with wireless communication systems (48:30-37) where the toy figures include freely mobile characters and a portable owl doll for users to carry (49:6-15 and 49:19-28) where the mobile character transmits information identifying the character (48:66-49:5) and information is received by the other figures (50:47-49). Gabai further

discloses that the figures have the ability to direct users to facilities in the theme park (56:34-39 and 56:65-57:9) as well as to direct them to the location of other users in the park (53:27-54:14). Gabai lacks explicitly stating that the portable toy would be able to notify the user that a mobile character is nearby.

6. In related prior art, Rose discloses a device responsive to receipt of a signal transmitted by another to automatically notify the user via the device that a character is nearby (2:16-40). One skilled in the art would recognize the stated advantages of a doll with responsive speech to provide inspiration for a child's imagination and to maintain the child's interest in said doll (1:59-2:15).

7. Therefore it would have been obvious to one skilled in the art at the time of the invention to have modified Gabai in view of Rose to have included a response to the signal of a nearby character in order to stimulate the child's imagination and maintain the child's interest in the doll.

8. In regards to claims 2 and 3, Gabai discloses the use of infrared or radio frequency signals (51:15-24).

9. In regards to claim 4, Gabai discloses that each figure or node has an ID (figure 43A, element 2850).

10. In regards to claim 5, Gabai discloses that the portable owl figure has memory (figure 71, element 4030 which is related to figure 6 with description 35:31-32).

Examiner contends that signals in the device must inherently be stored in some sort of memory in order for the device to processes and respond to such signals.

11. In regards to claim 6, Gabai discloses a system with a number of wireless signal transmitters at various locations throughout a theme park environment (48:66-49:5), that has a number of fanciful toy figures with wireless communication systems (48:30-37) where the toy figures include freely mobile characters and a portable owl doll for users to carry (49:6-15 and 49:19-28) where the mobile character transmits information identifying the character (48:66-49:5) and information is received by the other figures (50:47-49). Gabai further discloses that the figures have the ability to direct users to facilities in the theme park (56:34-39 and 56:65-57:9) as well as to direct them to the location of other users in the park (53:27-54:14). Gabai lacks explicitly stating that the portable toy would be able to notify the user that a mobile character is nearby.

12. In related prior art, Rose discloses a device responsive to receipt of a signal transmitted by another to automatically notify the user via the device that a character is nearby (2:16-40). One skilled in the art would recognize the stated advantages of a doll with responsive speech to provide inspiration for a child's imagination and to maintain the child's interest in said doll (1:59-2:15).

13. Therefore it would have been obvious to one skilled in the art at the time of the invention to have modified Gabai in view of Rose to have included a response to the signal of a nearby character in order to stimulate the child's imagination and maintain the child's interest in the doll.

14. In regards to claims 7 and 8, Gabai discloses the use of infrared or radio frequency signals (51:15-24).

15. In regards to claim 9, Gabai discloses a system that has a number of fanciful toy figures with wireless communication systems (48:30-37) and memory (figures 71 and 74, element 4030 and 4270 respectively, which are related to figure 6 with description 35:31-32), where the figures are able to receive signals and trigger playback of preprogrammed data related to received signals (instructs the child to stay put in response to being informed that the parent is searching for the child, 53:27-54:14) where the toy figures include freely mobile characters and a portable owl doll for users to carry (49:6-15 and 49:19-28) where the mobile character transmits information identifying the character (48:66-49:5) and information is received by the other figures (50:47-49). Gabai further discloses that the figures have the ability to direct users to facilities in the theme park (56:34-39 and 56:65-57:9) as well as to direct them to the location of other users in the park (53:27-54:14). Gabai lacks in explicitly stating that the portable toy would be able to notify the user that a mobile character is nearby.

16. In related prior art, Rose discloses a device responsive to receipt of a signal transmitted by another to automatically notify the user via the device that a character is nearby (2:16-40). One skilled in the art would recognize the stated advantages of a doll with responsive speech to provide inspiration for a child's imagination and to maintain the child's interest in said doll (1:59-2:15).

17. Therefore it would have been obvious to one skilled in the art at the time of the invention to have modified Gabai in view of Rose to have included a response to the signal of a nearby character in order to stimulate the child's imagination and maintain the child's interest in the doll.

18. In regards to claims 10 and 11, Gabai discloses the use of infrared or radio frequency signals (51:15-24).

19. In regards to claims 25-27, Gabai discloses that the toys may produce sound effects, music and speech (7:12-19 and 7:31-34).

20. Claims 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabai et al. (US 6352478).

21. In regards to claim 19, Gabai discloses a figure with wireless communication equipment (48:30-37) that receives information from a plurality of wireless transmitters in a surrounding environment that generate signals representing the location of objects and characters in the environment (48:66-49:5), memory (figures 71 and 74, element 4030 and 4270 respectively, which are related to figure 6 with description 35:31-32) preprogrammed with data related to location (56:34-39 and 56:65-57:9). Gabai further discloses the storage of data related to the events of a user in the park (51:63-52:25). Gabai further discloses the communicating with the user based on the user's event data (figures 52-57). Gabai does not explicitly disclose that the memory is located within the figure. However, at the time of invention it would have been an obvious matter of design choice to locate the memory within the device, be it within a device such as in the instant application or in a centralized location and transmitted to the device as in the system of Gabi. Each system produces the expected results of providing data to the interactive toy.

22. In regards to claim 20, the user's name is stored in memory (52:37-41).

23. In regards to claim 21, the toy addresses the user using the name from memory (figure 46A, element 2810).

24. In regards to claims 22 and 23, Gabai discloses the use of infrared or radio frequency signals (51:15-24).

25. In regards to claim 24, each object, location or character corresponds with a wireless signal transmitter (49:16-18).

### ***Response to Arguments***

26. Applicant's arguments filed 05/12/2008 have been fully considered but they are not persuasive. Applicant argues that Gabai does not disclose automatic notification by the device upon proximity to another device. Examiner respectfully disagrees. Gabai is a completely computerized system. To suggest that the system of Gabai does not operate automatically is to ignore the nature of a computing system and the teachings of Gabai as thoroughly set forth above. Nevertheless, examiner has included another teaching of such a system in the prior art.

### ***Conclusion***

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue



requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID W. DUFFY whose telephone number is (571)272-1574. The examiner can normally be reached on M-F 0830-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. W. D./  
Examiner, Art Unit 3714

/Corbett Coburn/  
Primary Examiner  
AU 3714